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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,091	09/04/2003	James J. LeKachman	47004.000216	5822
21967 7590 02/06/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
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TRAN, HAI				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/654,091

Applicant(s)

LEKACHMAN, JAMES J.

Examiner

HAI TRAN

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. On January 15, 2009, the Attorney contacted the Examiner regarding the finality of the last Final Office Action, mailed on 12/27/2008. After the conversation with the Attorney, the Examiner decides to issue this Corrected Final Office Action to the Applicant.
2. This is the **Corrected Final Office Action** in response to the telephone call with the Attorney and the Amendments filed on September 26, 2008 for application, titled: "System and Method for Financial Instrument Pre-Qualification and Offering".
3. Claims 14 and 31 have been amended. Accordingly, claims 1-31 are pending and have been examined.

Priority

4. This application claims the benefit of U.S. Provisional Patent Application No. 60/407,696, filed on 09/04/2002.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 14 and 31 recite "a customer of a financial institution or an entity associated with the financial institution" is unclear because "an entity associated with the financial institution" could mean "a vendor to the financial institution" and in this case, it is not the same as "a customer of a financial institution". The metes and bounds of the claims cannot be understood because of the lack of definiteness in the claims.
8. Claims 2-13 and 15-30 are also rejected because of their dependency on claims 1 and 14, respectively.
9. Claims 14-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claims 14 and 31 recite a conditional step of "offering ..., if confirmation is received" is unclear because the claims do not have the step(s) of what to do next if the confirmation is not received or if the confirmation is received but the consumer is NOT pre-qualified. The metes and bounds of the claims cannot be understood because of the lack of definiteness in the claims.
11. Claims 15-30 are also rejected because of their dependency on claim 14.
12. Appropriate correction is required.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 14-31 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The critical step or essential to the practice of the invention is not included in the claim(s) and hence is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

15. Claims 14 and 31 recite the steps of "receiving, inquiring, and offering" are inadequate because the critical step of "consumer contacts system" (see Applicant's Specification, Figure 3/element 315) is not disclosed in the claims. Without this critical step, the step of "inquiring" will not be initiated and the "offering" will not be completed.

16. Claims 15-30 are also rejected because of their dependency on claim 14.
Appropriate correction is required.

Response to Amendments/Arguments

17. Applicant's arguments, filed 9/26/2008, with respect to the amended claims 14-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 14-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al. (U.S. Patent No. 6,055,573) ("Gardenswartz") in view of Cunningham (Patent No. 7,310,617) ("Cunningham").

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

20. **Regarding to Claim 14**, Gardenswartz discloses a method for offering financial instruments to pre-qualified consumers, comprising:

receiving information related to personal identification information associated with a consumer who is a customer of a financial institution or an entity associated with the financial institution, the consumer personal identification information being transmitted prior to a consumer contact (see Gardenswartz, Figure 5/elements 500, 502; col. 10, lines 3-9, Figures 6, 7 and description);

inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with the financial institution (see Cunningham, col. 4, lines 22-6 of col. 6 and Figures 2 & 3); and

offering the consumer the financial instrument for which he or she is pre-qualified, if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument (see Cunningham, col. 6, lines 7-43 and Figure 4/element 74),

wherein the standards for the consumer pre-qualification are set by the financial institution (see Cunningham, col. 4, lines 23-11 of col. 5 and Figure 2/element 50).

Gardenswartz discloses a system and method for pre-qualifying a consumer for a "value contract" (see col. 3, lines 61-63) based his demonstrated purchase history behavior (col. 3, lines 5-17), but does not expressly teach pre-qualifying a consumer for a "financial instrument". However, Cunningham teaches a system and method for offering financial card (or financial instrument) to potential customers including the financial card applicant selection criteria and financial card term data. It would have been obvious to one of ordinary skill in the art to modify Gardenswartz's invention related to pre-qualifying consumer to include the features of financial card offering as taught by Cunningham to offer an improved system with different products to customers.

21. **Regarding to Claim 15**, Gardenswartz teaches the method of claim 14, wherein pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see Gardenswartz, col.3, lines 8-11, 46-59, col. 15, lines 19-40, figure 10/element 1000. Examiner notes that this is equivalent to checking the credit rating of a consumer).

22. **Regarding to Claim 16**, Gardenswartz teaches the method of claim 15, wherein pre-qualification of the consumer occurs prior to receipt of the consumer personal identification information (see Gardenswartz, Figure 5/element 504, 506, col. 10, lines

16-34 where consumers are classified and delivered targeted advertisements before they contact the stores).

23. **Regarding to Claims 17-18**, Gardenswartz teaches wherein the third party maintains consumer information in files indexed by a unique identifier, and wherein the unique identifier relates to the personal identification information of the consumer (see Gardenswartz, col. 3, lines 18-44, col. 5, lines 44-60).

24. **Regarding to Claim 19**, Gardenswartz teaches the method of claim 18, further comprising offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition (see Gardenswartz, col. 3, lines 5-17, 46-60).

25. **Regarding to Claims 20-21**, Gardenswartz teaches wherein the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive, and wherein the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see Gardenswartz, col. 14, lines 50-3 of col. 15).

26. **Regarding to Claim 22**, Gardenswartz teaches the method of claim 21, wherein the consumer is offered the financial instrument only if one or more pre-determined conditions are met (see Gardenswartz, col. 3, lines 46-60).

27. **Regarding to Claims 23-25**, Gardenswartz teaches wherein the consumer personal identification information is obtained when the consumer makes contact

comprises a purchase from a merchant (see col. 15, lines 8-18), wherein the consumer personal identification information is obtained through contact comprises one of a communication from a business partner of the financial institution or a communication directly to the financial institution (see col. 5, lines 44-60), and wherein consumer personal identification information is obtained through a telephone call or contact over a computer network (see Gardenswartz, col. 4, lines 26-44, col. 5, lines 32-42).

28. **Regarding to Claim 26**, Gardenswartz teaches the method of claim 25, further comprising offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see Gardenswartz, col. 3, lines 61-12 of col. 4).

29. **Regarding to Claim 27**, Gardenswartz teaches the method of claim 25, further comprising offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see Gardenswartz, col. 3, lines 32-44, col. 5, lines 44-60).

30. **Regarding to Claims 28-29**, Gardenswartz teaches wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information, and wherein the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see Gardenswartz, col. 3, lines 32-44, col. 4, lines 26-44, col. 5, lines 44-60).

31. **Regarding to Claim 30**, Gardenswartz teaches the method of claim 28, wherein authentication is performed by the third party (see Gardenswartz, col. 3, lines 36-44).

32. **Regarding to Claim 31**, this claim corresponds to claim 14 except that includes the limitation of “wherein further the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive” (see discussion in claims 20-21 above).

Response to Arguments

33. Applicant's arguments filed 9/26/2008 with respect to claims 1-13 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

36. **Regarding to Claims 1-13**, Applicant argues that claims 1 and 12 recite the subject matter related to claim 14 and thus, the arguments set forth with respect to claim 14 are equally applicable to claims 1 and 12 (see Remarks, page 14, second paragraph).

37. The Examiner respectfully disagrees. Since Applicant has amended claims 14 and 31 and thus the arguments are not completely and equally applicable to claims 1 and 12, and therefore the arguments are not persuasive. The Examiner determines that claims 1 and 12 recite the same subject matter as prior to the amendment of claims 14 and 31, and have the same limitations as before. Hence, they are remained rejected under the same rationale provided in the last Office Action.

Conclusion

38. Claims 1-31 are rejected.

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./
Examiner, Art Unit 3694

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/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694